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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,126	09/10/2003	Hun C. Lee	003-58	6914
47360	7590	12/05/2005	EXAMINER	
JAMES E. BRUNTON, ESQ. P. O. BOX 29000 GLENDALE, CA 91209			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,126

Applicant(s)

LEE ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Bank of Elmwood" advertisement, hereafter referred to as "Elmwood" in view of LaVanway '578, Woods '570, Learnard '866 and article by Echlin "New bank carries old name", hereafter referred to as Echlin.

Elmwood discloses a banking establishment having a children's window accessible (permitting the child access to the teller window as required by claim 9) by a child "...the child is entitled to use a special teller window just for Woody Savers..." as required by claim 6 and providing a specifically designed savings book (passbook) as required by claim 9.

Echlin discloses a banking establishment which, like Elmwood, has a child accessible teller window but goes further by teaching that such a window should be lowered/have a low counter (see 4th paragraph).

LaVanway teaches that it is known for a banking institution to have a plurality of teller windows (col. 1, lines 20-22 and figure 1) in order to service a plurality of customers as quickly as possible.

Woods discloses that it is known to provide a portable bank in the shape of a small pig, as required by claim 8, (pig 10) to a child after the child opens an account (see abstract) for the purpose of being able to store money at home if desired. Woods also discloses that it is known to provide a child account holder with a plurality of prizes depending on account criteria (col. 2, lines 62+) as an incentive.

Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have included a plurality of teller windows in the Elmwood bank for the purpose of servicing all of the customers, especially since the teller window disclosed in Elmwood is only for children having a "Woody Saver" account. Additionally, it would have been obvious to lower the counter of the child accessible window of Elmwood for the purpose of providing an easily accessible teller window to children and people in wheelchairs. It would have been further obvious to have included a portable bank and a plurality of prizes in combination with Elmwood for the purpose of allowing the child customer to store his/her account money at home or at the bank as well as well as to provide incentive in good account management and savings.

Regarding teller window panels and associated indicia provided thereon, as required by claim 6, LaVanway shows that it is known for teller windows to have panels (figure 1). While it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include illustrations attractive to children on the teller windows since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed

printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of aesthetic display does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. illustrations attractive to children) and the substrate (e.g. teller window panels) which is required for patentability.

Regarding the step of providing publications designed to teach banking procedures and establishing a plurality of savings goals and respective awards as required by claims 6 and 9. Learnard discloses that it is known to display brochures and other literature by a bank explaining the banks services (col. 1, lines 19-21). Therefore it would have been obvious to include publications explaining banking procedures and outlining savings goals and rewards for the purpose of providing the customer with desired bank and account information and since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of bank services and

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account description does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. information describing banking procedures and savings goals versus associated prizes) and the substrate (e.g. brochure or other literature) which is required for patentability.

Regarding claim 9, the steps of allowing a child to view the plurality of prizes and explaining to the child the steps to be followed prior to being awarded the selected prizes would have been obvious since the prior art (Elmwood and Woods) is clearly directed to teaching a child about banking and saving through awarding prizes in association with savings goals and steps of displaying prizes prior to awarding them are notoriously known in the art (bank brochures often display a variety of prizes/gifts for a variety of customer transactions that may be performed such as, a toaster for opening an account).

Regarding the step of teaching a child how to use a children's savings book, as required by claim 9, such a step would have been obvious since the prior art (Elmwood and Woods) is clearly directed to teaching a child about banking and saving and such teaching steps are notoriously known in the art (e.g. see Milne U.S. Patent 2,927,803 col. 1, lines 68-71 for an example of parents teaching children the use of a child savings book).

Response to Arguments

Applicant's arguments filed August 11th, 2005 have been fully considered but they are not persuasive. Applicants argue that the Elmwood reference fails to a lowered counter or illustrated side panels. In response the examiner directs applicants attention to the Echlin reference and maintains his position that the illustrations on the side panels are clearly a design choice and not patentable subject matter as clearly established in a variety of case law including *In re Gulack* 217 USPQ 401, (CAFC 1983).

Applicants further appear to argue that Learnard fails to disclose that his literature is not disclosed as a particular type which teaches banking procedure to children. However, as stated above, Learnard discloses that it is known to display brochures and other literature by a bank explaining the bank's services (col. 1, lines 19-21), therefore it would have been obvious to include publications explaining banking procedures and outlining savings goals and rewards for the purpose of providing the customer with desired bank and account information and since it would only depend on the intended use of the assembly and the desired information to be displayed. Furthermore, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of bank services and account description does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of

functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. information describing banking procedures and savings goals versus associated prizes) and the substrate (e.g. brochure or other literature) which is required for patentability.

Applicants further appear to argue that there is no suggestion/motivation to combine the references. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Elmwood clearly discloses a banking institution which caters to children with special teller windows and gifts and savings books (see reference). While, Echlin clearly teaches an improvement to the banking window of Elmwood by making the window lower so that it is easily accessible by children and the handicapped. LaVanway improves on the banking structure of Elmwood by clearly teaching that it is known for a banking institution to have a plurality of teller windows (col. 1, lines 20-22 and figure 1) in order to service a plurality of customers as quickly as possible. Woods improves on the Elmwood teachings by disclosing that it is known to provide a portable bank in the shape of a small pig to a child after the child opens an account for the purpose of being able to store money at home if desired. Woods also discloses that it is known to provide a child account holder with a plurality of prizes depending on account criteria (col. 2,

lines 62+) as an incentive. While Learnard discloses that it is known to display brochures and other literature by a bank explaining the banks services (col. 1, lines 19-21). Thus it would have been obvious to combine all of the above references at the time of the claimed invention as each reference provides an improvement to the teachings of Elmwood.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
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